

**REMARKS**

Claims 14-24 are pending in the application. By this Amendment, Claims 13 and 25-29 are canceled, without prejudice or disclaimer, and Claims 14-15 and 18-20 are amended. Support for the claim amendments is found in the specification at, *inter alia*, pages 5 and 7-9; in the original claims; and in the Figures. In addition, the Title is replaced with a new Title in view of the claim amendments. No new matter is added by this Amendment.

Entry of the Amendment is proper because it does not raise any new issues requiring further search and/or consideration; does not present any additional claims without canceling a corresponding number of finally rejected claims; and places the application in better form for appeal, should an appeal be necessary. Claims 15 and 18-20 are simply placed in independent form.

Applicant thanks Examiner Anthony Stashick for the courtesies extended to his representative during the June 8, 2004 personal interview. Applicant's separate record of the telephonic interview is set forth in the foregoing amendments and the following remarks.

**I. FORMAL MATTERS**

Claims 13-29 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

The Office Action asserted that Claim 13 has insufficient antecedent basis for the term "the sole" in lines 2-3 and "the boot" in lines 3 and 5. Claim 13 is canceled, thereby rendering the rejection moot. Accordingly, the scope of Claims 14-24 would have been reasonably ascertainable to one of ordinary skill in the art in view of the specification and the drawings. The requirements of 35 U.S.C. 112, second paragraph,

are satisfied. Reconsideration and withdrawal of the rejection are respectfully requested.

## II. REJECTIONS UNDER 35 U.S.C. 102(b)

A claim is anticipated under 35 U.S.C. 102(b) only if *each and every element* as set forth in the claim is found in a single prior art reference.

### A. McKenzie et al.

Claims 13-18, 21, 23-24, and 27-29 were rejected under 35 U.S.C. 102(b) as anticipated by McKenzie et al. (U.S. Patent No. 5,493,794). This rejection is respectfully traversed.

McKenzie et al. discloses a snowshoe. A binding cooperates upon the snowshoe for evenly distributing a user's weight thereupon (Abstract). As discussed at the interview, McKenzie et al. is directed to a snowshoe and does not disclose any boot. One of ordinary skill in the art would certainly understand that the snowshoe and binding of McKenzie et al. is not a boot. A boot is a "protective piece of footgear . . . covering the foot and part or all of the leg". See the attached definition from The American Heritage Dictionary and corresponding picture of a ski "boot". See also FIGS. 1-2 of the present application.

McKenzie et al. does not disclose a boot having a sole insert that runs transversely to the sole and has two ends, each end positioned on a lateral edge of the sole of the boot. Thus, McKenzie does not disclose each and every element of Claims 14-18, 21, or 23-24. Reconsideration and withdrawal of the rejection are respectfully requested.

B. Massicotte

Claims 13-18, 20-21, 23-24, and 27-29 were rejected under 35 U.S.C. 102(b) as anticipated by Massicotte (U.S. Patent No. 3,344,538). This rejection is respectfully traversed.

Massicotte discloses mechanically hinged snowshoes. Unlike McKenzie et al., Massicotte discloses a shoe 12. The shoe 12 comprises a sole 36 and a heel 37. See FIG. 3.

In a first embodiment, the sole 36 may have a separate block 40 affixed on its underside. The block 40 may have a transverse metal sleeve 41 therethrough for receiving stub shaft 34 and a terminal portion of bolt 22 (col. 2, lines 39-46). See FIGS. 3-4. In this embodiment, the sleeve extends to the edges of block 40, not to lateral edges of sole 36.

In a second embodiment, sleeve 41a extends through the sole of shoe 12 as shown in FIG. 2A. As Applicant's representative argued at the interview, in this embodiment, the sleeve 41a would necessarily change in length depending upon the size of the sole. Thus, Applicant's representative argued that neither embodiment of Massicotte discloses that the length of the sole insert is independent of the size of the boot and is designed to be used on at least two different boot sizes.

The Examiner questioned this understanding of Massicotte, specifically pointing to FIG. 4 and asserting that the length of the "sole insert" (i.e., metal sleeve 41) is limited by the distance between blocks 16, 17 and could be the same for different boots. However, even if the Examiner's interpretation is correct, the metal sleeve of the first embodiment is in block 40, not sole 36, and therefore does not have each end positioned on a lateral edge of the sole. For the second embodiment in which a metal sleeve is actually in the sole 36, the sleeve would change in length depending upon the size of the sole. Thus,

Applicant maintains that Massicotte does not disclose that the length of the sole insert is independent of the size of the boot and is designed to be used on at least two different boot sizes. Massicotte does not disclose each and every element of Claims 14-17 and 23-24. Reconsideration and withdrawal of the rejection are respectfully requested.

As to Claim 18, referring to FIGS. 6a-6c, Applicant's representative argued that Massicotte does not disclose the boot recited in Claim 18. Massicotte does not disclose a boot comprising: (1) a sole having protruding contours or bosses, or hollow contours, on its lateral edges; and (2) a sole insert that runs transversely to the sole, each end being positioned on a lateral edge of the sole and located in the protruding contours or bosses, or hollow contours. Compare FIG. 6a (protruding contours 6) and FIG. 6b (hollow contours).

At the interview, pointing to FIGS. 8a-8b, Applicant's representative also argued that Massicotte does not disclose a boot comprising: (1) a sole, wherein the width of the sole varies in its height; and (2) a sole insert, wherein a vertical position of the sole insert differs depending on the size of the boot for a given boot model, as recited in Claim 20.

Applicant also notes that Massicotte does not disclose a sole insert that is positioned in the sole in such a way that a ratio between: (1) a distance measured between the transverse axis of the sole insert and the front end of the boot, and (2) the length of the boot, is the same regardless of the size of the boot, as recited in Claim 21. See FIG. 7a-7c.

Massicotte does not disclose each and every element of Claims 18 and 20-21. Reconsideration and withdrawal of the rejection are respectfully requested.

C. WO 00/13538

Claims 13-19, 21-24 and 27-29 were rejected under 35 U.S.C. 102(b) as anticipated by WO 00/13538. This rejection is respectfully traversed.

WO '538 discloses shoes that can be used in common for a plurality of fittings (Abstract). The shoe has a sole portion 14 having at least two through holes 24 penetrating therethrough along the width. It appears that element 26 is inserted into the through holes.

As to Claims 14-17 and 23-24, the through holes 24 of WO '538 would clearly change in length as the shoe is increased or decreased in size. WO '538 does not disclose that the length of the sole insert is independent of the size of the boot and is designed to be used on at least two different boot sizes, as recited in Claim 15. In fact, the entire objective of WO '538 is contrary to the objective of the claimed boot. WO '538 is directed to one shoe that can be used with a plurality of fittings. In contrast, the present invention is directed to a plurality of boots having the same insert that can be used with one fitting. See specification at page 1, line 20 - page 2, line 12. WO '538 does not disclose each and every element of Claims 14-17 and 23-24. Reconsideration and withdrawal of the rejection are respectfully requested.

WO '538 does not disclose the boot of Claim 18. WO '538 does not disclose a boot comprising: (1) a sole having protruding contours or bosses, or hollow contours, on the lateral edges; and (2) a sole insert that runs transversely to the sole and each end is positioned on a lateral edge of the sole and is located in the protruding contours or bosses, or hollow contours. See FIG. 6a and FIG. 6b.

WO '538 also does not disclose the boot of Claim 19. WO '538 does not disclose a boot comprising: (1) a sole; and (2) a sole insert, wherein a longitudinal position of the sole insert varies as a function of size for a given boot model, whereby the sole insert is

Barboux - Serial No. 10/053,005  
Amendment after Final Rejection under 37 CFR 1.116  
Docket No. GASQ-101

positioned in a front part of the boot at a point where the width of the sole is equal to the length of the sole insert. See FIGS. 7a-7c. In contrast, the shoe of WO '538 has a plurality of through holes.

WO '538 also does not disclose a sole insert that is positioned in the sole in such a way that a ratio between: (1) a distance measured between the transverse axis of the sole insert and the front end of the boot, and (2) the length of the boot, is the same regardless of the size of the boot, as recited in Claim 21. See FIG. 7a-7c. Thus, WO '538 does not disclose the subject matter of Claims 18-19 and 21-22. Reconsideration and withdrawal of the rejection are respectfully requested.

### III. REJECTION UNDER 35 U.S.C. 103(a)

Claims 25-26 were rejected under 35 U.S.C. 103(a) over any one of McKenzie et al., Massicotte, and WO '538. To advance prosecution, Claims 25-26 are canceled, thereby rendering the rejection moot. Reconsideration and withdrawal of the rejection are respectfully requested.

### IV. CONCLUSION

In light of the foregoing remarks, this application is in condition for allowance, and early passage of this case to issue is respectfully requested. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated.

This Amendment is accompanied by a Petition under 37 CFR §1.136(a) for a three month extension of time and a check in the amount of \$475 in payment of the required extension fee.

Barboux - Serial No. 10/053,005  
Amendment after Final Rejection under 37 CFR 1.116  
Docket No. GASQ-101

This Amendment is also accompanied by a Notice of Appeal and a check in the amount of \$165 in payment of the required extension fee.

This Amendment is also accompanied by check in the amount of \$43.00 in payment of the additional independent claim fee.

Any additional fees should be charged to, or any overpayment in fees should be credited to, Deposit Account No. 501032 (Docket #GASQ-101).

Respectfully submitted,



Warren A. Zitlau  
Registration No. 39,085

Barry I. Hollander  
Registration No. 28,566

Hollander Law Firm, P.L.C.  
Suite 305, 10300 Eaton Place  
Fairfax, Virginia 22030  
Tel: (703) 383-4800  
Fax: (703) 383-4804

June 30, 2004

Attachments:

The American Heritage Dictionary, p 197.  
Check for \$43.00

CERTIFICATE OF MAILING  
I hereby certify that this correspondence dated 6/30/04 is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on 6/30/04.

  
HOLLANDER LAW FIRM, P.L.C.  
Suite 305  
10300 Eaton Place  
Fairfax, Virginia 22030

Date: 6/30/04